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In re Application of	:	DECISION ON RENEWED
Clark et al.	:	
Application No.: 10/585,261	:	
PCT No.: PCT/US2005/000638	:	
Int. Filing Date: 07 January 2005	:	PETITION UNDER
Priority Date: 07 January 2004	:	
Attorney's Docket No.: 10159NP	:	
For: BIOMARKERS AND METHODS...	:	
FACTOR RECEPTOR MODULATORS	:	37 CFR 1.137(a)

This decision is in response to Petitioner's "Renewed Petition Under 37 CFR 1.181," which is being treated as a renewed petition under 37 CFR 1.137(a) filed on 15 January 2010.

### **BACKGROUND**

In a decision from this Office on 21 August 2009, the petition filed on 18 June 2009 was dismissed because item (3) of 37 CFR 1.137(a) was not met.

On 15 January 2010, petitioner filed a renewed petition under 37 CF 1.137(a), which includes a copy of all the replies docketed for a date of two months (around December 24, 2009) from the mail date of the non-received Office communication, which was mailed from the USPTO on October 24, 2008.

### **DISCUSSION**

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(l); (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The renewed petition is deemed to satisfy the items under 37 CFR 1.137(a).

Petitioner has satisfied item (3) under 37 CFR 1.137(a). In this application, no terminal disclaimer is required.

With respect to item (3), the showing of record by petitioner is adequate to establish an unavoidable delay within the meaning of 37 CFR 1.137(a). The analysis is based on the standard of Withdrawing Holding of Abandonment.

MPEP section 711.03(c) establishes the requirement to show nonreceipt of an Office action. It states that:

“The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

A review of the renewed petition reveals that petitioner has compiled with the requirements set forth in section 711.03(c), which requires a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed for reply dated of two(2) months (around December 24, 2008) from the date of mailing of the Notice of Missing Requirements.

Petitioner has submitted a tickler showing all the replies docketed for a date of two months (around December 24, 2008) from the mail date of the non-received Office communication.

Accordingly, petitioner has met the requirements under MPEP section 711.03(c) to establish nonreceipt of an Office action.

### **DECISION**

The petition under 37 CFR 1.137(a) is **GRANTED**. The Notification of Abandonment (PCT/DO/EO/909) mailed 15 May 2009 was in error and is hereby **VACATED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision. The 35 USC 371 (c)(1), (c)(2), and (c)(4) date of this application is **18 June 2009**.

  
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